

REMARKS

I. Introduction

With the addition of new claims 21 to 25, claims 10 to 25 are now pending. In view of the following remarks, it is respectfully submitted that claims 10 to 25 are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for considering the previously-filed Information Disclosure Statement, PTO-1449 paper and cited references.

Applicants note that the Office Action Summary does not acknowledge the claim for foreign priority and does not indicate whether the priority document has been received. Applicants note, however, that the Notification of Missing Requirements Under 35 U.S.C. § 371 mailed on March 19, 2002 indicates receipt of the priority document. Applicants respectfully requests that the Examiner acknowledge in the next office action the claim for foreign priority and receipt of the priority document.

II. Rejection of Claims 10-20 under 35 U.S.C. § 103(a)

Claims 10 to 20 were rejected under 35 U.S.C. § 103(a) as being unpatenable over U.S. Patent No. 6,302,551 (“Matumoto”) in view of U.S. Patent No. 6,404,463 (“Knoll”). It is respectfully submitted that claims 10 to 20 are allowable for at least the following reasons.

Initially, Applicants note that Matumoto is not a valid prior art reference against the present application. Matumoto has a U.S. filing date of May 24, 2000, which is after the priority date of the present application, May 2, 2000. Furthermore, Matumoto was issued on October 16, 2001, which is after the effective U.S. filing date of the present application, April 27, 2001. Accordingly, since Matumoto is not a valid prior art reference against the present application, and since Knoll clearly does not anticipate claims 10 to 20 (as acknowledged by the Examiner), the obviousness rejection of claims 10 to 20 based on Matumoto and Knoll should be withdrawn. Independent of these reasons, Applicants note

that the substantive teachings of Matumoto and Knoll fail to render obvious claims 10 to 20, as explained in detail below.

To reject a claim as obvious under 35 U.S.C. § 103, the prior art must describe or suggest each claim feature, and there must be a motivation or suggestion to modify or combine the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). This motivation or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Claim 10 recites:

An illumination device for a display instrument, comprising:
a dial face;
a pointer scale arranged on the dial face;
a first scale marking arranged on a first side of the pointer scale on the dial face;
at least one of a second scale marking and an auxiliary scale arranged on a second side of the pointer scale on the dial face;
a first light source for illuminating the first scale marking;
an optical waveguide into which a light of the first light source is injected, the light being deflected from the optical waveguide to the second scale marking;
at least one second light source for illuminating the pointer scale; and
a light funnel arranged between the at least one second light source and the pointer scale, wherein:
a light path from the at least one second light source to the pointer scale is separated from the optical waveguide by the light funnel.

Matumoto, by contrast, purportedly relates to an instrument panel 10 for a vehicle, which includes a speedometer 20 and a tachometer 40. See Matumoto, col. 2, lines 45 to 51, and Figure 2. The speedometer 20 includes a scale plate 20a made of a transparent material and a scale/character part 21 having scales and characters, which are written in black. See Matumoto, col. 2, lines 60 to 64. The tachometer 40 has substantially the same structure

as the speedometer 20 and includes a scale plate 40a with a display pattern part 41. See Matumoto, col. 4, lines 35 to 40.

Matumoto also discloses that first background light sources 81 are arranged circumferentially behind the speedometer 20 so as to light the scale plate 20a of the speedometer 20 from a backside thereof. See Matumoto, col. 3, lines 61 to col. 4, line 2. Second background light sources 82 are also arranged circumferentially behind the speedometer 20 and supply light into a dish-shaped light guiding plate 60, which then directs the light to the backside of the scale plate 20a of the speedometer 20. See Matumoto, col. 4, lines 2 to 11. In this regard, the first and second background lights 81 and 82 do not illuminate the display pattern part 41 of the tachometer 41. Indeed, the dish-shaped light guiding plate 60 does not extend beyond the scale plate 20a of the speedometer 20. See Matumoto, col. 3, lines 30 to 39.

The Office Action asserts on page 2 through page 3 that the scale/character part 21 of the speedometer 20 is a “first scale marking” and the display pattern part 41 of the tachometer 40 is a “second scale marking,” and that col. 3, line 30 through col. 4, line 23 of Matumoto disclose an optical waveguide into which light of a first light source for illuminating the scale/character part 21 is injected and deflected to the display pattern part 41. However, as discussed above, the light guiding plate 60 referred to in col. 3, line 30 through col. 4, line 23 of Matumoto **does not extend beyond** the scale plate 20a of the speedometer 20 and therefore **does not and cannot deflect light to the display pattern part 41 or to any part of the tachometer 40**. Accordingly, the assertion by the Office Action that Matumoto discloses an optical waveguide as recited claim 10 is without basis. In particular, it is respectfully submitted that Matumoto does not disclose an optical waveguide into which a light of a first light source for illuminating a first scale marking arranged on a first side of a pointer scale on a dial face is injected and deflected to a second scale marking arranged on a second side of the pointer scale on the dial face, as recited in claim 10.

The Examiner further asserts on page 3 of the Office Action that col. 3, line 30 through col. 4, line 23 of Matumoto disclose a light funnel arranged between at least one

second light source for illuminating the pointer scale, wherein a light path from the at least one second light source to the pointer scale is separated from the optical waveguide by the light funnel. Applicants respectfully disagree, and Applicants submit that col. 3, line 30 through col. 4, line 23 do not disclose these features as recited in claim 10. Moreover, Applicants request that the Office provide further clarification since it is believed that without further elaboration Applicants are unfairly forced to speculate as to what exactly is the supporting basis for this assertion made by the Examiner. In particular, it is respectfully requested that the Office explicitly identify which elements referred to in col. 3, line 30 through col. 4, line 23 of Matumoto are asserted to be “a light funnel and at least one second light source,” and precisely where in col. 3, line 30 through col. 4, line 23 it is disclosed that “a light path from the at least one second light source to the pointer scale is separated from an optical waveguide by the light funnel.”

Knoll purportedly relates to an electro-optic display device for a combination instrument of a motor vehicle, in the form of a **liquid crystal display**. See Knoll, col. 3, lines 9 to 11, and Abstract. It is respectfully submitted that Knoll does not disclose an optical waveguide into which a light of a first light source for illuminating a first scale marking arranged on a first side of a pointer scale on a dial face is injected and deflected to a second scale marking arranged on a second side of the pointer scale on the dial face, as recited in claim 10. Indeed, the Office Action does not assert that Knoll discloses these features.

For the foregoing reasons, the combination of Matumoto and Knoll fails to disclose all of the features of claim 10, in particular, an optical waveguide into which a light of a first light source for illuminating a first scale marking arranged on a first side of a pointer scale on a dial face is injected and deflected to a second scale marking arranged on a second side of the pointer scale on the dial face. Accordingly, even if it were proper to combine the Matumoto and Knoll references as suggested (which is not conceded, as explained below in further detail), it is respectfully submitted that such combination does not render unpatentable claim 10, or any claims which ultimately depend from claim 10 or claims that recite analogous features, including claims 11 to 20.

It is also respectfully submitted that the Office Action's asserted suggestion to combine the Matumoto and Knoll references is plainly based on nothing more than hindsight reasoning. In this regard, in rejecting a claim under 35 U.S.C. § 103, Applicant's invention "must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time." Indeed, the Office Action does not even assert that it would have been obvious at the time the invention was made to make such a combination. Accordingly, combining these prior art references without evidence of a proper suggestion, teaching, or motivation "simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight." In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

Moreover still, it is respectfully submitted that a *prima facie* case of obviousness has not been made in the present case, since the Office Action never made any findings, such as, for example, regarding what the ordinary skill level in the art would have been at the time the claimed subject matter of the present application was made. (See In re Rouffet, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998) (the "factual predicates underlying" a *prima facie* "obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art"))). It is respectfully submitted that the proper test for showing obviousness is what the "combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art," and that the Patent Office must provide particular findings in this regard -- the evidence for which does not include "broad conclusory statements standing alone." (See In re Kotzab, 55 U.S.P.Q. 2d 1313, 1317 (Fed. Cir. 2000) (citing In re Dembiczak, 50 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1999) (obviousness rejections reversed where no findings were made "concerning the identification of the relevant art," the "level of ordinary skill in the art" or "the nature of the problem to be solved")))). It is again respectfully submitted that there has been no such showing by the Office Action.

In fact, it is respectfully submitted that the lack of any of the required factual findings in the Office Action forces Applicants to resort to unwarranted speculation to

ascertain exactly what facts underlie the present rejections. The law requires that the Patent Office provide the factual basis for rejecting a patent application under 35 U.S.C. § 103. (See In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) (citing In re Warner, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967))). In short, the Office has failed to carry the initial burden of presenting a proper prima facie case of obviousness. (See In re Oetiker, 977 F.2d 1443, 1445, 24, U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)).

In view of the foregoing, it is respectfully submitted that claims 10 to 20 are allowable over the references relied upon, whether taken individually, combined or modified. It is respectfully requested that the rejection of claims 10 to 20 under 35 U.S.C. § 103(a) be withdrawn.

VII. New Claims 21 to 25

New claims 21 to 25 do not add any new matter and are fully supported by the present application, including the Specification. Claims 21 to 25 depend either directly or indirectly from claim 10, and are therefore allowable for at least the same reasons as claim 10.

CONCLUSION

In view of all of the above, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections be withdrawn. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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